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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,592	09/05/2003	Makoto Saga	108421-00079	7317

4372 7590 08/10/2004

ARENT FOX KINTNER PLOTKIN & KAHN  
1050 CONNECTICUT AVENUE, N.W.  
SUITE 400  
WASHINGTON, DC 20036

EXAMINER

MORILLO, JANEL COMBS

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/655,592	Applicant(s) SAGA, MAKOTO	
	Examiner Janelle Combs-Morillo	Art Unit 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) 3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>090403</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of group I claims 1-2 in the reply filed on July 6, 2004 is acknowledged. Additionally, applicant requested claim 3 (which depends on claim 1) be rejoined to claim 1 upon allowance of claim 1, pursuant to MPEP 821.04. The examiner agrees to rejoin said claim upon the allowance of claim 1.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 60-159145 (JP'145) or JP 60-159147 (JP'147).

JP'145 teaches an Al-Mg alloy with 2.5% Mg, 1.0% Cr, 0.2% Cu (page 4 column 2, ex. 9), which falls within the alloying ranges of instant claim 1. Additionally, JP'145 teaches an Al-Mg alloy with 2.0% Mg, 0.6% V, 1.0% Cr, and 0.1% Cu (page 4 column 2 ex. 17), which falls within the alloying ranges of instant claims 1 and 2.

JP'147 teaches an Al-Mg alloy with 1.3% Mg, 0.8% Mn, 1.0% Cr, and 0.2% Cu (page 4 column 1 ex. 5), which falls within the ranges of instant claim 1. Additionally, JP'147 teaches an Al-Mg alloy with 0.8% Mg, 0.6% Mn, 2.0% V, and 0.1% Cu (page 4 column 1 ex. 4), which falls within the alloying ranges of instant claims 1 and 2.

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The phrase “for rapidly cooled welding” as claimed is held to define merely an intended use for the alloy composition. Because the prior art teaches an Al-Mg alloy plate product with superior strength (see abstracts), said alloy appears to be capable of performing said intended use as recited in the preamble. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997), MPEP 2111.02.

Because JP’145 or JP’147 teach examples within the presently claimed alloying ranges, and because said alloys are held to be suitable for the presently claimed intended use, it is held that JP’145 or JP’147 anticipates the presently claimed invention.

4. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 10-237577 (JP’577).

JP’577 teaches an Al-Mg alloy for welding with 4.0-7.0% Mg, 0.01-1.5% Mn, 0.01-0.5% V, 0.05-3.0% Ni, and 0.05-0.2% Cu (abstract), which overlaps the presently claimed alloying ranges of claims 1 and 2. Additionally, JP’577 teaches Ex. 11 in Table 1 comprises: 4.5% Mg, 0.85% Mn, and 0.08% Cu, which falls within the ranges of instant claim 1. Also, Ex. 5 in Table 1 comprises of: 6.0% Mg, 1.5% Mn, 3.0% Ni, and 0.06% Cu, which falls within the ranges of instant claim 1.

Concerning the phrase “for rapidly cooled welding”, JP’577 teaches that said Al-Mg alloy is suitable for welding. Because the prior art teaches an Al-Mg alloy plate product suitable for welding, said alloy appears to be capable of performing said intended use as recited in the preamble. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997), MPEP 2111.02.

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Because JP'577 teaches examples within the presently claimed alloying ranges, and because said alloys are held to be suitable for the presently claimed intended use, it is held that JP'577 anticipates the presently claimed invention.

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janelle Combs-Morillo whose telephone number is (571) 272-1240. The examiner can normally be reached on 8:30 am- 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JCM  
July 30, 2004

ROY KING   
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700